

E) REMARKS/ARGUMENTS

This Response is filed in response to an Office Action dated March 23, 2006.

Upon entry of this response, claims 17-19, 21-23, 26-28, 30-32, 34, 36 and 38-39 will be pending in the Application.

In the outstanding Office Action, the Examiner rejected claims 17-19, 21-23, 26-28, 30-32, 34, 36 and 38-39 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement and failing to comply with the written description requirement. The Examiner withdrew the previous rejections based upon prior art. However, the Examiner reconsidered the limitation "the particles being physically separated from one another" and indicated that this limitation failed to comply with 35 U.S.C. § 112, first paragraph.

Rejection under 35 U.S.C. § 112, First Paragraph

The Examiner rejected claim 17-19, 21-23, 26-28, 30-32, 34, 36 and 38-39 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement and the written description requirement. The Examiner further indicated that the rejections may be withdrawn if scientific reasoning is presented explaining how the particles are physically separated from one another. Specifically, the Examiner stated the following:

Attorney Docket No. 13DV-13124-2 (07783-0149-D2)
Application No. 10/663,320

7. Claims 17-19, 21-23, 26-28, 30-32, 34, 36, and 38-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In claims 17, 26, and 32, lines 15-16 of each, the limitation "the particles being physically separated from one another" is not enabled in the specification. Upon close review of the specification, it is the Examiner's position that there is no teaching how to make the claimed invention, specifically how to make and maintain the particles physically separated from one another. It is noted that Figure 10 (which is the only figure depicting the claimed embodiment) illustrates that the particles are physically separated from one another, as argued by Applicant, however there is nothing in the specification enabling an artisan having ordinary skill in the art how or why the claimed separation of particles in a fluid medium would be achieved. In a typical fluid medium containing non-spherical metal particles, at least some of the particles would be touching or abutting since the particles are randomly mixed in the fluid. If Applicant can provide scientific reasoning as to why all particles remain physically separated, then the rejection will be withdrawn.

8. Claims 17-19, 21-23, 26-28, 30-32, 34, 36, and 38-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 17, 26, and 32, lines 15-16 of each, the phrase "the particles being physically separated from one another" added in the amendment of July 11, 2005 appears to be new matter. Since separation of particles is not discussed in the specification, it appears that the particle separation illustrated in Figure 10 is merely an exemplary drawing and not limiting of the invention, absent scientific reasoning otherwise from Applicants. For this reason, the claim limitation "the particles being physically separated from one another" remains rejected as being new matter.

In response to the Examiner's rejection, Applicants submit the declaration of Andy Skoog under 37 C.F.R. § 1.132 providing both factual support for the limitation "the particles being physically separated from one another" and evidence that the limitation is enabled by the present invention. As indicated in the declaration, explicit support for the physical separation of the particles within the coating medium is shown in, among other locations, Figures 5-10 of the specification (see Paragraph 4 of Declaration).

Declarant Skoog explains the physical separation of the particles within the coating medium is due to the surface tension of the selected particle and the viscosity of the coating medium (see Paragraph 5 of Declaration). It is further noted in the Declaration that the support for this conclusion is present in the specification, as originally filed at least on page 14, lines 11-13, 17-21 and 23-26; and page 15, lines 5-8 (see Paragraph 5 of Declaration). Declarant Skoog further explains that

the medium material contacts the particle and forms a barrier layer, which impedes particle-to-particle contact and allows movement of the individual particles within the medium (see Paragraph 6 of Declaration). Declarant Skoog continues explaining that the barrier layer resulting from the surface tension of the particle and the particle separation facilitates rotation in response to a force to provide the alignment of the particles in the major dimension (see Paragraph 7 of Declaration). In addition to the rotation in response to force, Declarant Skoog notes that surface tension and gravity act further upon the non-spherical particles during curing, maintaining the separation between particles and permitting at least about 50% of the particles to be aligned in the direction of the major dimension, wherein support for this conclusion is present at least at page 15, lines 5-8 of the specification.

Given the above factual evidence presented in the Declaration of Andrew J. Skoog, Applicant submits that the limitation, "the particles being physically separated from one another", is both supported by the specification as originally filed and enabled by the specification as originally filed. Accordingly, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 112, first paragraph.

CONCLUSION

In view of the above, Applicants respectfully request reconsideration of the Application and withdrawal of the outstanding rejections. As a result of the remarks presented herein and the submission of the declaration under 37 C.F.R. § 1.132, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. 112, first paragraph and submit that claims 17-19, 21-23, 26-28, 30-32, 34, 36 and 38-39 are thus in condition for allowance. As the claims are not anticipated nor rendered obvious by the applied art in view of the applied art and the claims and enabled and supported by the specification as originally filed, Applicants request allowance of claims 17-19, 21-23, 26-28, 30-32, 34, 36 and 38-39 in a timely manner. If the

Attorney Docket No. 13DV-13124-2 (07783-0149-D2)
Application No. 10/663,320

Examiner believes that prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact the Applicants.

The Commissioner is hereby authorized to charge any additional fees and credit any overpayments to Deposit Account No. 50-1059.

Respectfully submitted,
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